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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,145	04/21/2004	Yuh-Cherng Wu	13906-122001 / 2003P00271	5096
32864	7590	12/26/2008	EXAMINER	
FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			PESIN, BORIS M	
		ART UNIT	PAPER NUMBER	
		2174		
			NOTIFICATION DATE	DELIVERY MODE
			12/26/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/829,145	WU, YUH-CHERNG	
	<b>Examiner</b>	<b>Art Unit</b>	
	BORIS PESIN	2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 September 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-15 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

This communication is responsive to the amendment filed 9/24/2008.

Claims 1-15 are pending in this application. Claims 1, 6 and 11 are independent claims. In the amendment filed 9/24/2008, Claims 1, 6, and 11 were amended. This action is made Non-Final.

### ***Specification***

Claims 11-15 are objected to because of the following informalities:

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not discuss “tangibly” storing information.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 5-8, 10-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over SAP Wizard Builder (NPL provided by the applicant in IDS called Screen Shots of a Wizard Builder sold by SAP AG, 7 sheets) in view of Cobb et al. (US 7117447).

Re claim 1, SAP Wizard Builder substantially discloses a method to be executed as part of a process for creating an executable configuration program that comprises multiple steps that are successively executed and wherein associated with each of the steps are user-selectable options, the method comprising: creating a rule that during execution of the configuration program determines which of the user-selectable options for a step are displayed when a specified user-selectable option of a previous step is selected; and binding the rule to the specified user selectable option so that during execution of the configuration program the rule is executed when the specified user-selectable option is selected (rule created and binded to execute the rule binded to the specific option when user selects the user-selectable option as claimed above is shown in figures 4-7 for example, also see annotation in figure below). SAP Wizard Builder does not explicitly disclose storing the rule in a repository and binding it in the

repository. It would have been an obvious matter of design choice to store and bind the rule in the repository, since such a modification would have involved the mere application of a known technique such as storing programming to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396).

SAP does not specifically teach generating a user interface including at least (i) a logic flow area for a user to define a command structure for the configuration program including at least one step and (ii) a refinement area for the user to specify a configuration detail regarding a step arranged in the logic flow area and wherein the step and the previous step are arranged in the logic flow area and the user specifies the rule in the refinement area. Cobb teaches generating a user interface including at least (i) a logic flow area for a user to define a command structure for the configuration

program including at least one step and (ii) a refinement area for the user to specify a configuration detail regarding a step arranged in the logic flow area and wherein the step and the previous step are arranged in the logic flow area and the user specifies the rule in the refinement area (See Figures 7 and 18). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify SAP and include a logic flow area and a refinement area with the motivation to provide the user with a simpler method of creating the logic flow.

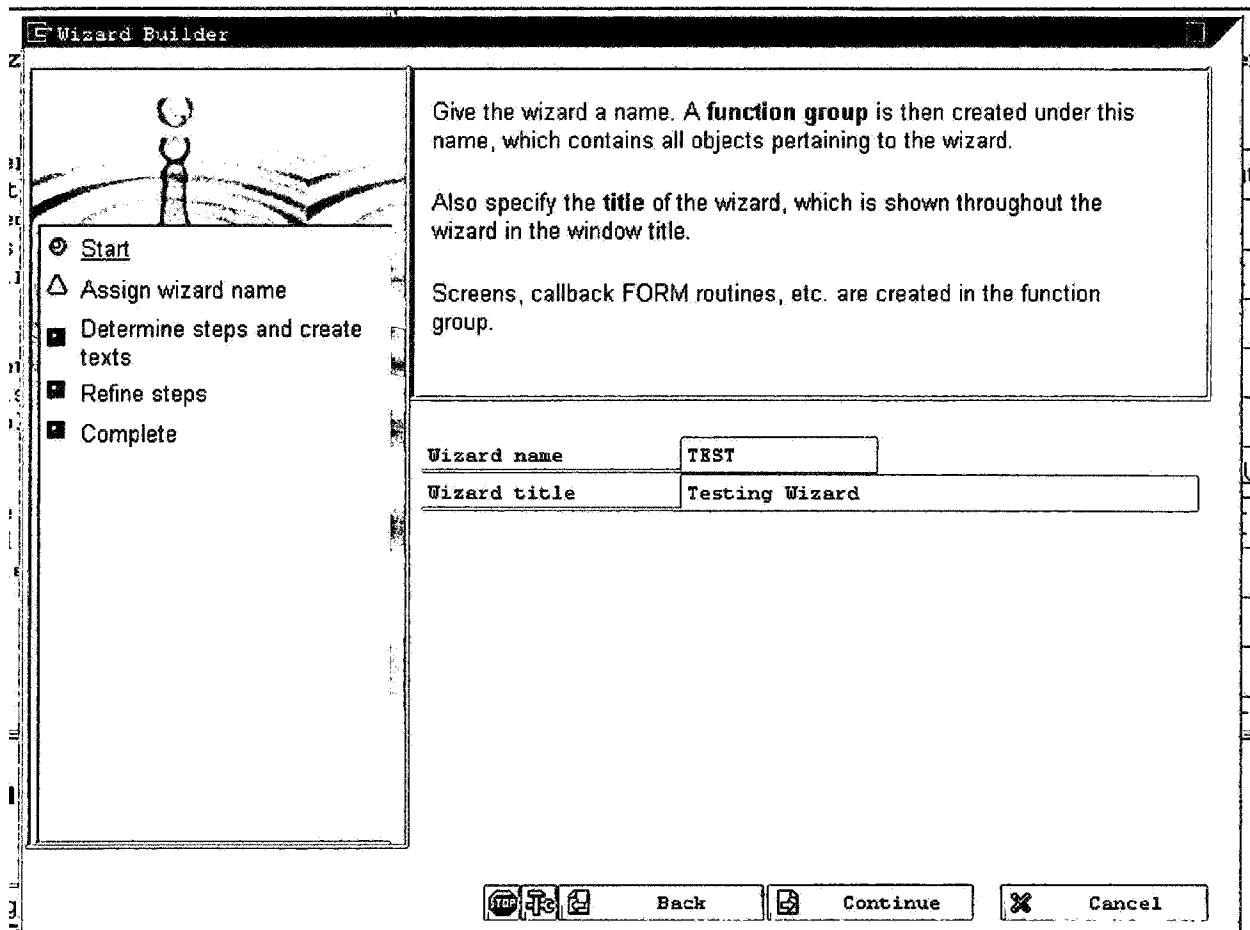
Re claim 2, note that SAP Wizard Builder discloses a method wherein the binding of the rule to the specified user-selectable option is performed by virtue of a designer selecting a user-selectable option for which to create the rule (inherent, since pages 4-7 show that the user-selectable options are set as created by the designer).

Re claim 3, SAP Wizard Builder substantially discloses a method further comprising: creating a textual explanation of the step that describes available user-selectable options for the step; and binding the textual explanation to the step so that during execution of the configuration program the textual explanation of the step is displayed (see annotated figure below for example). SAP Wizard Builder does not explicitly disclose storing the textual explanation in a repository and binding it in the repository. It would have been an obvious matter of design choice to store and bind the textual explanation in the repository, since such a modification would have involved the mere application of a known technique such as storing programming to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere

application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Re claim 5, note that SAP Wizard Builder discloses a method further comprising evaluating the stability of a configured software application by executing the software application using a simulated user-selectable option (see page 3, execute in diagnosis mode for example).

User-selectable options steps displayed	Textual explanation of the step
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Re claim 6, SAP Wizard Builder substantially discloses a system comprising: a computer network (inherently used to execute the wizard builder); a service delivery device coupled to the network, the service delivery device including a processor and memory storing instructions that, in response to receiving a first type of request for

access to a service (inherently used to execute the wizard builder), cause the processor to: create an executable configuration program that comprises multiple steps that are successively executed and wherein associated with each of the steps are user-selectable options; create a rule that during execution of the configuration program determines which of the user-selectable options for a step are displayed when a specified user-selectable option of a previous step is selected; and bind the rule to the specified user-selectable option so that during execution of the configuration program the rule is executed when the specified user-selectable option is selected (rule created and binded to execute the rule binded to the specific option when user selects the user-selectable option as claimed above is shown in figures 4-7 for example, also see annotation in figure above). SAP Wizard Builder does not explicitly disclose storing the rule in a repository and binding it in the repository. It would have been an obvious matter of design choice to store and bind the rule in the repository, since such a modification would have involved the mere application of a known technique such as storing programming to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results;

absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

SAP does not specifically teach generating a user interface including at least (i) a logic flow area for a user to define a command structure for the configuration program including at least one step and (ii) a refinement area for the user to specify a configuration detail regarding a step arranged in the logic flow area and wherein the step and the previous step are arranged in the logic flow area and the user specifies the rule in the refinement area. Cobb teaches generating a user interface including at least (i) a logic flow area for a user to define a command structure for the configuration program including at least one step and (ii) a refinement area for the user to specify a configuration detail regarding a step arranged in the logic flow area and wherein the step and the previous step are arranged in the logic flow area and the user specifies the rule in the refinement area (See Figures 7 and 18). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify SAP and include a logic flow area and a refinement area with the motivation to provide the user with a simpler method of creating the logic flow.

Re claim 7, note that SAP Wizard Builder discloses a system wherein the memory stores instructions that, in response to receiving the first type of request, cause the processor to bind the rule to the specified user-selectable option by providing an ability to select a user-selectable option for which to create the rule (rule created and

binded to execute the rule binded to the specific option when user selects the user-selectable option as claimed above is shown in figures 4-7 for example, also see annotation in figure above).

Re claim 8, SAP Wizard Builder substantially discloses a system wherein the memory stores instructions that, in response to receiving the first type of request, cause the processor to: create a textual explanation of the step that describes available user-selectable options for the step; and bind the textual explanation to the step so that during execution of the configuration program the textual explanation of the step is displayed (see annotated figure above for example). SAP Wizard Builder does not explicitly disclose storing the textual explanation in a repository and binding it in the repository. It would have been an obvious matter of design choice to store and bind the textual explanation in the repository, since such a modification would have involved the mere application of a known technique such as storing programming to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for

one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Re claim 10, note that SAP Wizard Builder discloses a system wherein the memory stores instructions that, in response to receiving the first type of request, cause the processor to evaluate the stability of a configured software application by executing the software application using a simulated user-selectable option (see page 3, diagnosis mode for example).

Re claim 11, SAP Wizard Builder substantially discloses an article comprising a machine-readable medium storing machine-readable instructions (inherently used for displaying and using the Wizard Builder) that, when applied to the machine, cause the machine to: create an executable configuration program that comprises multiple steps that are successively executed and wherein associated with each of the steps are user-selectable options; create a rule that during execution of the configuration program determines which of the user-selectable options for a step are displayed when a specified user-selectable option of a previous step is selected; and bind the rule to the specified user-selectable option so that during execution of the configuration program the rule is executed when the specified user-selectable option is selected (rule created and binded to execute the rule binded to the specific option when user selects the user-selectable option as claimed above is shown in figures 4-7 for example, also see annotation in figure above). SAP Wizard Builder does not explicitly disclose storing the rule in a repository and binding it in the repository. It would have been an obvious

matter of design choice to store and bind the rule in the repository, since such a modification would have involved the mere application of a known technique such as storing programming to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396).

SAP does not specifically teach generating a user interface including at least (i) a logic flow area for a user to define a command structure for the configuration program including at least one step and (ii) a refinement area for the user to specify a configuration detail regarding a step arranged in the logic flow area and wherein the step and the previous step are arranged in the logic flow area and the user specifies the rule in the refinement area. Cobb teaches generating a user interface including at least (i) a logic flow area for a user to define a command structure for the configuration program including at least one step and (ii) a refinement area for the user to specify a

configuration detail regarding a step arranged in the logic flow area and wherein the step and the previous step are arranged in the logic flow area and the user specifies the rule in the refinement area (See Figures 7 and 18). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify SAP and include a logic flow area and a refinement area with the motivation to provide the user with a simpler method of creating the logic flow.

Re claim 12, note that SAP Wizard Builder discloses an article including instructions that, when applied to the machine, cause the machine to bind the rule to the specified user-selectable option by providing an ability to select a user-selectable option for which to create the rule (see pages 4-7 for example).

Re claim 13, SAP Wizard Builder substantially discloses an article including instructions that, when applied to the machine, cause the machine to: create a textual explanation of the step that describes available user-selectable options for the step; and bind the textual explanation to the step so that during execution of the configuration program the textual explanation of the step is displayed (see annotated figure above for example). SAP Wizard Builder does not explicitly disclose storing the textual explanation in a repository and binding it in the repository. It would have been an obvious matter of design choice to store and bind the textual explanation in the repository, since such a modification would have involved the mere application of a known technique such as storing programming to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a

known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Re claim 15, note that SAP Wizard Builder discloses an article including instructions that, when applied to the machine, cause the machine to evaluate the stability of a configured software application by executing the software application using a simulated user-selectable option (see page 3, diagnosis mode for example).

Claims 4, 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over SAP-Cobb in view of Watson-Luke et al. (20050114240).

Re claim 4, SAP Wizard Builder-Cobb substantially discloses a method as set forth in claim 3 above SAP Wizard Builder does not explicitly disclose wherein creating the textual explanation comprises translating the textual explanation into at least one different language. However, Watson-Luke et al. teaches of wherein creating the

textual explanation comprises translating the textual explanation into at least one different language (see paragraph 0297 for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein creating the textual explanation comprises translating the textual explanation into at least one different language of Watson-Luke et al. on the method of SAP Wizard Builder-Cobb in order to provide different language support.

Re claim 9, SAP Wizard Builder-Cobb substantially discloses a system as set forth in claim 8 above SAP Wizard Builder does not explicitly disclose wherein the memory stores instructions that, in response to receiving the first type of request, cause the processor to translate the textual explanation into at least one different language. However, Watson-Luke et al. teaches of wherein the memory stores instructions that, in response to receiving the first type of request, cause the processor to translate the textual explanation into at least one different language (see paragraph 0297 for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein the memory stores instructions that, in response to receiving the first type of request, cause the processor to translate the textual explanation into at least one different language of Watson-Luke et al. on the system of SAP Wizard Builder in order to provide different language support.

Re claim 14, SAP Wizard Builde-Cobbr substantially discloses an article as set forth in claim 13 above SAP Wizard Builder does not explicitly disclose when applied to the machine, cause the machine to translate the textual explanation into at least one different language. However, Watson-Luke et al. teaches of when applied to the

machine, cause the machine to translate the textual explanation into at least one different language (see paragraph 0297 for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have when applied to the machine, cause the machine to translate the textual explanation into at least one different language of Watson-Luke et al. on the article of SAP Wizard Builder in order to provide different language support.

***Response to Arguments***

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

***Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BORIS PESIN whose telephone number is (571)272-4070. The examiner can normally be reached on Monday-Friday except every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Boris Pesin/  
Examiner, Art Unit 2174